

DEC 12 2005

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF  
JEFFREY ROMINE, ET AL.

ART UNIT: 1626

APPLICATION NO: 10/637099

EXAMINER: SAEED, KAMAL A

FILED: AUGUST 8, 2003

FOR: IMINOTHAZOLIDINONES AS INHIBITORS OF HCV  
REPLICATION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In the Office Action dated September 22, 2005 restriction to one of the following groups was required:

- I. Claims 1-26, are drawn to products of the Formula depicted in claim 1, classified in various subclasses of classes 514, 544, 546 and 548.
- II. Claims 27-38, are drawn to methods of use classified in various subclasses of class 514.

As stated on page 5 of the Office Action, the Examiner's position is:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that

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product (MPEP § 806.05(h)). In the instant case the product as claimed can be in a materially different process with as shown in claims 27-38.

In addition, because of the plethora of classes and subclasses in each of the Groups, a serious burden is imposed on the examiner to perform a complete search of the defined areas.

However, the Examiner's assertion is unsupported by an example of how the product as claimed can be used in another materially different process. MPEP § 806.05(h) states that "The burden is on the examiner to provide an example". Therefore, it is respectfully submitted that the U.S. Patent and Trademark Office has failed to meet its burden to support the restriction requirement. Hence, for the foregoing reason, the restriction requirement is traversed.

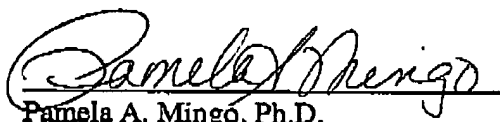
Notwithstanding the traverse, applicants provisionally elect the invention of Group I, claims 1-26.

Further, applicants elect the species from the structure of compound 97 set forth on page 82 and described in Table 2 on page 102. Claims 1, 3-6, 8, 10, 12-14, 16, and 18-26 read on the elected species.

An early and favorable Office Action is courteously solicited.

A request for an extension of time of two months is filed herewith.

Respectfully submitted,



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